

REMARKS

Applicants earnestly but respectfully request the Examiner to reconsider and withdraw all objections and rejections before passing this case on to allowance.

Applicants respectfully acknowledge the Examiner's courtesies during telephone discussions conducted on or about March 30, 2004. The undersigned and the Examiner discussed the Declaration filed herein on March 25, 2004. Due to delays in the mail, the Declaration "crossed" with the Office Action dated March 24, 2004. It is understood from the constructive discussions had with Examiner Vogel that the prior art rejection based on U.S. Patent No. 5,959,176 will now be withdrawn for reasons of record. The utility rejection under 35 U.S.C. §101 was also discussed and the amended claims which refer to "isolated promoter" or the like are thought to address the rejection and it is understood that the rejection would be withdrawn consistent with the telephone interview with the Examiner.

Applicants present claims 1-4 and 6-16 for examination. Amended claim 1 finds basis in the specification throughout. Applicants, do, however, respectfully invite the Examiner's attention to page 7, line 26, to page 12, line 5, with respect to the language characterizing the hybridization and the conditions. The recited conditions include washing, and attention is respectfully invited to page 10, lines 20-21. Amended claim 3 refers to "an isolated promoter of claim 1", albeit somewhat redundant in view of amended claim 1. The amended claim 4 brings this claim within the ambit of elected claimed subject matter and is consistent with the specification at, for instance, page 21, line 18, through page 22, line 2. Amended claim 4 refers to "an isolated promoter of claim 1", albeit somewhat redundant in view of amended claim 1. The terminator as recited in claims 4 and 7 finds support in the specification throughout. The Examiner will also note page 21, line 18, through page 23, line 25. Amended claims 4 and 7 also do not depend from non-elected claim 2. Applicants make the amendment without prejudice to timely filing a divisional application. Amended claims 13 and 14 recite "an isolated promoter of ...". New claim 15 presents the correct original version of original claim 5, and additionally includes the word "isolated." Any inconvenience to the Examiner is

regretted. New claim 16 finds basis in the specification throughout, including the originally presented claims, as well as the specification at page 7, line 26, through page 12, line 5, which includes page 10, lines 20-21. All claims have been presented with corrected conventional type ("SEQ ID NO: ___"), for a sequence listing, but this has no affect on claim scope.

Applicants respectfully request the Examiner to reconsider and withdraw the objection to claims 4 and 7-9. Applicants also respectfully request the Examiner to reconsider and withdraw the objection to claims 8 and 9 under Rule 75(c).

Applicants respectfully request the Examiner to reconsider and withdraw the prior art rejection of claims 1-3, 7, 10, 13 and 14 under 35 U.S.C. §102(e) over the Torikai et al. patent, USP 5,959,176. The present application and the cited patent have common inventive entities. Any "difference" in one of the names is the result of marriage and a name change as evidenced by the Declaration submitted herein on March 25, 2004.

The rejection of claims 1, 3, 13 and 14 under 35 U.S.C. §101 may be withdrawn. Applicants have adopted the Examiner's suggestion to insert the word "isolated" in such claims.

Applicants earnestly but respectfully submit claims 1, 3-7, 10, 13 and 14 comply with the requirements of 35 U.S.C. §112(¶1). These claims are supported by a specification which describes the claimed subject matter in such a way as to reasonably to convey to one skilled in the relevant art, or the art to which the inventions most nearly pertain, that, at the time the application was filed, the inventors had possession of their claimed invention(s).

Claim 1 as currently amended is drawn to an isolated promoter comprising DNA (a) or (b), wherein DNA (b) comprises a nucleotide sequence in which one or more bases are deleted, substituted, or added in the nucleotide sequence shown in SEQ ID NO:1, which has more than 90% identity to the nucleotide sequence of any region containing

250 bp or more within the nucleotide sequence shown in SEQ ID NO:1, and which contains the nucleotide sequence in SEQ ID NO:24, and which hybridizes to the nucleotide sequence shown in SEQ ID NO:1 under conditions that include washing in 300mM sodium chloride, 30mM sodium citrate, 1% SDS at 55°C, wherein the DNA (b) has promoter functions equivalent to those of DNA (a). DNA (a) comprises the nucleotide sequence shown in SEQ ID NO:1. The specification discloses SEQ ID NO:1 throughout. The claim appears to be objected to on the basis of DNA (b) being directed to a fragment which has more than 90% identity to any region of at least 250 base pairs of SEQ ID NO:1.

The specification specifically teaches a person skilled in the art that the present promoter DNA (b) may be obtained by labeling, for example, DNA comprising at least a part of the nucleotide sequence shown in SEQ ID NO:1 or SEQ ID NO:7, and hybridizing it as a probe to DNAs derived from a plant or the like to detect and clone DNAs to which the probe specifically binds. Specification, page 7, bottom of the page. DNA hybridization is described generally and specifically in the present application, and the general concept of DNA hybridization¹ is thought to be within the knowledge of a person skilled in the art, especially when taking the present specification into consideration at, for instance, pages 7-12. The present specification describes colony hybridization and plaque hybridization at page 7. The specification describes a membrane for such procedures at pages 8-9. Reagent and temperature conditions are described at pages 9-10. Claim 1 as amended refers to a washing step. A washing step is described in the specification at page 10. DNA obtained can be assayed as described at page 11.

Applicants therefore respectfully submit their specification does describe the claimed promoters comprising DNA (b) in such full, clear, concise and exact terms as to indicate that Applicants had possession of such promoters at the time of filing the present

¹It is a term discussed in various references, such as Biotechnology from A to B, Oxford Univ. Press (2nd Ed. 1998), Biotechnology, a dictionary of terms, American Chemical Society (1995; A Dictionary of Genetics, Oxford Univ. Press (5th Ed. 1997). The Examiner may also note as further examples the literature cited in the specification at pages 8, 9, 11, 12, 13 and 14 in conjunction with the detailed written description.

application, whereby they further respectfully submit the specification satisfies the written description requirement of 35 U.S.C. §112(¶1).

In connection with the foregoing traverse, Applicants again respectfully submit that they have presented a representative number of nucleotide sequences that fall within the scope of the claimed DNA (b). Applicants again respectfully invite the Examiner to consider SEQ ID NO:3, SEQ ID NO:4, SEQ ID NO:5 and SEQ ID NO:7. Applicants respectfully submit that the claims include a structural attribute, namely the nucleotide sequence recited in SEQ ID NO:24. That is SEQ ID NO:3, SEQ ID NO:4, SEQ ID NO:5 and SEQ ID NO:7 satisfy structural attributes that are common to the members of the claim 1(b) DNA, that is: DNA comprising the nucleotide sequence in which one or more bases are deleted, substituted, or added in the nucleotide sequence shown in SEQ ID NO:1, and which has more than 90% identity to the nucleotide sequence of any region consisting of 250 bp or more within the nucleotide sequence shown in SEQ ID NO:1, and which contains the nucleotide sequence shown in SEQ ID NO:24. These representative numbers of sequences and their recited structural attributes are in addition to the specific guidance provided, *via* hybridization, for isolation of the claimed DNA (b).

Applicants appreciate that the foregoing is a synopsis of an argument presented previously herein and they rely upon such prior argument(s) as if set forth herein. The prior argument(s) is presented in the February 20, 2004 Amendment, at, for instance, pages 7-9, and in the June 3, 2003 Amendment.

As noted in the prior responses, Applicants specification is directed to a person who is skilled in the art, or the art to which the inventions most nearly pertain. Applicants respectfully submit that such a person would appreciate from the specification that a so-called TATA is an element in a DNA to provide the promoter function in a plant cell.² For instance, such a person skilled in the art would read this present specification and it would have understood that the so-called TATA box provides a DNA binding site for transcription factor IID in a plant cell. With such a understanding, a person who is skilled

²June 3, 2003 Amendment, page 11; February 20, 2004 Amendment, page 10.

in the art would have appreciated from the present specification that DNAs described as having such promoter function would have at least in common a TATA box encoded there.

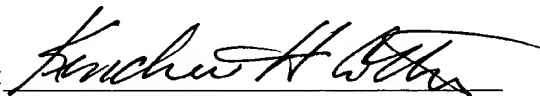
Applicants earnestly but respectfully submit that their originally filed specification satisfies the PTO's written description requirement, which requirement, as seen from the recent decisions from the Federal Circuit, is the subject of judicial debate.

Applicants respectfully submit that they have endeavored in good faith to respond to all matters presented in the Office Action of March 24, 2004. If the Examiner has any questions or concerns, please telephone the undersigned to arrange for a personal interview.

Applicants otherwise respectfully submit their application is now in condition for a Notice of Allowance and respectfully solicit such Notice.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

By: 
Kendrew H. Colton
Registration No. 30,368

Customer No. 42798
FITCH, EVEN, TABIN & FLANNERY
1801 K Street, NW - Suite 401L
Washington, DC 20006-1201
Telephone: (202) 419-7000
Facsimile: (202) 419 -7007